

REMARKS AND DISCUSSION

Upon entry of the present Amendment, claims 1-16 remain in the application. Of these, claims 1, 7, 11 and 15 are independent. Claims 1, 2, 7, 11 and 15 are amended herein. The amendments are clearly supported in the specification, whereby no new matter is added to the application. The above-identified Office Action has been reviewed, the references carefully considered, and the Examiner's comments carefully weighed. In view thereof, the present Amendment is submitted.

It is contended that by the present amendment, all bases of rejection set forth in the Office Action have been traversed and overcome. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

AMENDMENTS PRESENTED

In the Claims: Applicant has amended each of the independent claims 1, 2, 7, 11 and 15 herein to more particularly point out and distinctly claim the invention. Specifically, claims 1, 7, 11 and 15 further define a selector which automatically selects performance evaluation comments from a stored plurality of comments based on operator input in a simulated driving route sequence, by a driving operation of the student operator in a driving route sequence determined in advance in a running route upon the simulation apparatus, without requiring concurrent input from an outside source other than the operator.

Claim 2 has been amended to define a student operator.

Applicant respectfully submits that the above amendments are fully supported by the original disclosure, including the drawings, specification and claims, and directly pertain to important aspects of the present invention. Applicant also respectfully submits that no new matter is introduced into the application by the above amendments because the entire subject matter thereof was expressly or inherently disclosed in the original claims, specification and drawings.

CLAIM REJECTIONS - 35 USC §112

First Paragraph

At page 2, item 2, of the Office Action, the Examiner rejected claims 1-16 under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserted that in her view, the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's Response:

Upon careful consideration of the Examiner's rejections and the relevant sections of the MPEP and well established case law, applicant respectfully traverses such rejection, because contrary to the Examiner's assertion, no new matter was added by the last amendment.

Applicant respectfully submits that all of the current claim language is fully supported by the specification as originally filed. The original specification would clearly disclose to a person of ordinary skill in the art that the system according to the disclosed embodiment selects performance evaluation comments from a stored plurality of comments, based on operator input in a simulated driving route sequence, by a driving operation of the student operator in a driving route sequence upon the simulation apparatus, without requiring concurrent input from an outside source other than the operator. Applicant strongly traverses the Examiner's assertion of new matter, and respectfully requests reconsideration and withdrawal of such assertion.

The first paragraph of Section 112 is directed to the specification, rather than to the claims, and requires an enabling disclosure.

The first paragraph of 35 U.S.C. §112 reads as follows:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or

with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Applicant respectfully submits that the specification of the present application contains an enabling disclosure, and is in full compliance with the requirements set forth in the first paragraph of 35 U.S.C. 112.

In considering whether there is 35 U.S.C. 112, ¶ 1 support for claim limitations, the Examiner must consider not only the original disclosure contained in the summary and detailed description of the invention portions of the specification, but also the original claims, abstract, and drawings. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991) (drawings); *In re Wolfensperger*, 302 F.2d 950, 955-957, 133 USPQ 537, 541-543 (CCPA 1962) (drawings).

Additionally, applicant further disagrees with such rejection of the Examiner, since persons of ordinary skill in the art would well understand that “an outside source” referred to in the claims is consistent with “the instructor” and “the instruction device” referred throughout the application. Moreover, applicant respectfully points out that according to well-established practice and policy at the USPTO, literal support is not required; in other words, the claims do not have to use the exact wording of the specification in order to satisfy the description requirement.

Section 2163.07(a) of the Manual of Patent Examining Procedure, under the heading “Inherent Function, Theory, or Advantage”, states that

“By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973).

In the present application, paragraphs [059] and [081] of the specification make it clear that a number of performance evaluation comments are stored in the hard drive for different driving

situations. Paragraph [080] makes it clear that a performance evaluation commentary is selected for each driving situation and stored in a student operator simulated driving result table for that particular performance. Paragraphs [090] and [091] of the specification make it clear that during a replay operation of a specified student performance, the driving result table is referenced to select performance evaluation commentary corresponding to the simulated student driving result of the pertinent driving situation, and the selected performance evaluation commentary is output to the display unit and also read aloud over the speaker. Paragraph [104] of the specification makes it clear that a separate instruction apparatus for use by an instructor is eliminated, and even if an instructor who gives guidance is absent, relevant performance review comments can be selected and displayed by the simulator according to the invention.

Applicant therefore respectfully submits the claim limitation that the selector automatically selects performance evaluation comments from a stored plurality of comments based on operator input in a simulated driving route sequence “without requiring concurrent input from an outside source” is *inherently disclosed by the original specification* as filed, and that the introduction of such language into the claims did not constitute new matter.

Moreover, the disclosed embodiment, as described, is clearly able to select and display performance evaluation comments, based on operator input in a simulated driving route sequence, without requiring concurrent input from any outside source other than the student operator.

Based on the foregoing, applicant respectfully submits that the rejection of claims 1-16 under 35 USC 112, first paragraph, has been overcome, and it is respectfully requested that such rejection be reconsidered and withdrawn.

Second Paragraph

At page 2, item 4, of the Office Action, the Examiner rejected claims 1-16 as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

invention. The Examiner had a number of specific objections to the claim language, asserting that a number of terms used did not have sufficient antecedent basis.

The second paragraph of 35 U.S.C. §112 reads as follows:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Applicant's Response:

As stated above, applicant has amended claims 1, 7, 11 and 15 herein. Upon careful consideration of the Examiner's rejection, the MPEP, well established case law and in view of the above amendments, applicant respectfully submits that such rejection is overcome. Applicant submits that the Manual of Patent Examining Procedure. MPEP 2173.02 states as follows, on the subject of the standard under the second paragraph of section 112:

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

In the case of *Solomon v. Kimberly-Clark Corp.*, *supra*, the court stated:

The definiteness of the language employed must be analyzed - not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art . . . Determining whether a claim is definite requires an analysis of whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the

claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.

(upholding validity of a claim which included the terms "relatively thick layer" and "substantially thinner layer")

In the case of *In re Venezia*, 189 USPQ 149, 151-152 (CCPA 1976), the Court of Claims and Patent Appeals explicitly addressed the question of whether claim elements including the language "adapted to" were in compliance with the requirements of 35 USC 112. The invention at issue in *Venezia* was a kit of components for building a high-voltage splice connector. The claim at issue in *Venezia* included the terms "capable of being assembled", "adapted to be fitted", "adapted to be affixed", and "adapted to be positioned". The court in *Venezia* stated:

We have reviewed the disputed claims and in particular the language criticized by the examiner and the board. We conclude that the claims do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity, and that they are, therefore, definite as required by the second paragraph of section 112 (citations omitted) More particularly, we find nothing indefinite in these claims. One skilled in the art would have no difficulty determining whether or not a particular collection of components infringed the collection of interrelated components defined by these claims.

As noted above, Applicant has amended each of the independent claims 1, 7, 11 and 15 herein to more particularly point out and distinctly claim the invention. As presently amended, applicant submits that all of the claims are in full compliance with section 112.

Based on the foregoing, applicant respectfully submits that the rejection of claims 1-16 under 35 USC 112, second paragraph, has been overcome, and it is respectfully requested that such rejection be reconsidered and withdrawn.

35 USC §103 -- Obviousness

1. At page 3, item 6, of the Office Action, the Examiner rejected claims 1-3 and 6 under 35 USC 103 as unpatentable over the previously applied primary reference Aoki et al. (JP 2002-297017) in view of newly applied references Busse et al., Walker et al., and Brink et al.

The Examiner has taken the position that in her view, the combination of these references makes obvious all elements of the claimed invention. Thus, according to the Examiner, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the applied references to achieve the claimed invention.

Applicant's Response:

Upon careful consideration of the Examiner's rejection and the applied references, applicant respectfully traverses such ground of rejection for the several reasons stated herein.

For example, applicant submits that as discussed in the background of the present specification, Aoki '017 teaches a simulation apparatus incorporating a *separate monitoring device* (display unit) *for use by an instructor*. This is directly contrary to the claimed invention, which provides a simulated system that *does not require the input of an outside source* (such as a separate monitoring device or instructor).

Aoki '017 discloses a motorcycle riding simulation system directed to providing improved front and rear images for accurate simulation of motorcycle riding conditions. The system may be used for training/instruction of vehicle operators in cooperation with an instructor, and includes a running mode selector, which permits the instructor to designate a running mode (ie, ordinary road mode, traffic confusion mode, dangerous condition mode, etc.) (col. 8, line 66 -col. 9, line 12). Generated video output is recorded by a video image signal recording apparatus 32, and after simulation completion, problems of the riding method can be verbally explained by the instructor to the rider while showing the reproduced picture image (col. 11, line 65 - col. 12, line 3; col. 20, line 44-50).

Relative to the Examiner's rejection of claim 1, applicant submits that Aoki fails to disclose *a selector for selecting performance evaluation comments*, as claimed. Applicant notes that Aoki discloses a selector (Abstract, col. 25, lines 9-13) which permits selection of a running mode, but disagrees that the disclosed selector performs a function corresponding to selection of performance

evaluation comments, as is claimed by the applicant. In particular, the applicant notes that the system of Aoki does not “select”, but instead *permits an operator of the system to make a selection*. This is different than the claimed apparatus, which comprises a *selector which automatically selects performance evaluation comments*. That is, the claimed apparatus does not require an instructor to select or identify appropriate performance evaluation comments, and the apparatus performs the selection without input from the user or from an instructor.

In addition, the applicant disagrees with the Examiner’s assertion that selection of an operating mode, regardless of whether the system makes the selection or whether an operator makes a selection, anticipates selection of *performance evaluation comments*, since an operating mode of a vehicle, or of a simulator, is clearly unrelated to performance evaluation and *commentary* on performance evaluation.

Moreover, applicant submits that Aoki fails to teach, disclose or suggest *a display unit which simultaneously displays the simulated operating environment and the performance evaluation comments when the driving simulation is replayed on the display unit*, as claimed. In particular, Aoki does not disclose superimposing text or images comprising performance evaluation comments on the video image of the recording of the corresponding action by the rider during a simulated operation. Instead, Aoki discloses that while the video image is replayed, the instructor may provide instructive commentary to the rider (col. 20, lines 44-50), whereby the comments are spoken by the instructor and not displayed or audibly produced by the system.

Aoki discloses the display 408 as showing only the forward view image of scenery viewed by the rider/operator. Although Aoki discloses providing a television display 30 for the instructor, and although the display 30 includes plural areas (TV, 35, 37, 38) in which different outputs from the video signal composer 26 are displayed simultaneously, the display 30 is disclosed as provided for (used by) the instructor, the image viewed by the rider consists only of the replay of the simulation as displayed on the flat screen display 408 via video projector 402, and Aoki does not

disclose displaying performance evaluation comments on any portion of the display 30. Simultaneous *display* of the simulated operating environment and performance evaluation comments are not disclosed by Aoki. Hence, Aoki '071 is evidence of the non-obviousness of the claimed invention.

Further, Busse fails to disclose *a selector which automatically selects performance evaluation comments based on operator input in a simulated driving route sequence*. Further still, the deficiencies of the Aoki reference are not overcome or rectified by any of the other applied references when considered singly or in combination thereof and Walker and Brink are non-analogous art and cannot reasonably be relied upon by the Examiner to initiate, sustain and maintain the obviousness rejection.

Applicant respectfully notes that Busse discloses a video race car simulation that provides the user the option of simulating a full or partial simulation of a given race or entire season which according to Busse allows the user to enjoy the gaming experience more while removing the tedium previously associated with game options that slow down the game (yellow flags, etc.). For instance, if a player decides to terminate a race before it is actually finished, the simulation module can make a determination of the outcome of the race using already compiled statistics and the performance of the individual cars in the race up to that point [0007]. The simulation module also allows the user to simulate the next race within a series without entering the actual race and the race is simulated based on collected information about the vehicles in the race and their attributes to produce appropriate simulation data (Busse, para. [0008]).

Relative to the Examiner's repeated assertions throughout the Office Action that in her view, Busse discloses a selector which automatically selects performance evaluation comments based on operator input in a simulated driving route sequence, applicant respectfully suggests traverses such characterization of Busse, and submits that such assertion by the Examiner is *not justified* based on

the actual teachings of Busse.

For example, Busse discloses at paragraph [0040] that when a race is initiated or continued after a cautionary (yellow flag) period a “Pit Under Caution?” pop-up or other selectable option is displayed and the *player’s remaining fuel, tires, and damage meters are shown*. In this regard, we note that *Busse merely discloses options for the player to choose* from that are automatically displayed for the player, and along with the options, relative statistics are also displayed. These selectable queries and associated statistics displayed to the player are *not equivalent to the performance evaluation comments* of the present invention. The alleged performance evaluation comments provided by Busse are merely a compilation of performance *related statistics* compiled by the simulation mode (e.g. lap time, total time, position relative to other drivers, aggressiveness of driver, wear of vehicle, tires, etc.).

Additionally, Busse discloses an automatic “simulated” operation that is performed by his system in the instance where the player does not complete a race or does not enter the next race in a series of races during a season. We note that although, these simulated race standings are automatically determined by the simulation module based on the operator input (past race statistics), these race standings and finishing spots are not analogous to the performance evaluation comments as presently disclosed.

Moreover, Busse is fundamentally distinct from the present invention. Firstly, as discussed above, Busse discloses numerical statistics (alleged by the Examiner to disclose the performance evaluation comments of the present invention) that are compiled by the simulation mode to simulate full or partial game play. Distinct from any teaching of Busse, the performance evaluation comments of the present invention are *constructive comments* that aid the operator in assessing current skills so that the operator can constructively improve his or her driving skills. Additionally, Busse is directed to a video game system used primarily for entertainment. To combine such a system intended for entertainment with an instructional system such as disclosed by Aoki or even

consider it analogous to the present invention is not obvious.

Relative to Walker, applicant respectfully suggests that Walker is *non-analogous art* to the present invention because Walker discloses and is related to a method and apparatus for obtaining, filtering, storing, arranging, displaying, selling and/or providing access to information relating to a primary document (newspaper article), but which may only be referenced or partially included in the primary document [0003]. Walker's stated objective is to provide a method and apparatus that capitalizes on interviews conducted by newspaper reporters by providing a more thorough and complete interview based on a majority of the interview instead of the bits of information that is currently used such that the more thorough interview provides more supplemental information that is interesting to the readers [0005]-[0007]. Walker proposes a method and apparatus (system) that generates a modified transcript of an interview without creating new time commitments or responsibilities for a journalist or an editor [0008].

Therefore, given the nature of the modified transcript of Walker, persons skilled in the art would recognize that: 1) it does not pertain to the field of endeavor of interactive driving simulation apparatus; and 2) Walker does not address a problem similar to those addressed and overcome by the claimed invention. Hence, persons skilled in the art would recognize that Walker's modified transcript is not analogous to the presently claimed invention, and persons skilled in the art would not have looked to Walker even if such persons were considering possible modifications to Aoki's and Busse's disclosed systems.

Regarding Brink, applicant respectfully suggests that the Brink reference teaches away from the present invention, thus providing prima facie evidence of non-obviousness and also provides another example of non-analogous art, in a manner similar to Walker. For example, we note that Brink discloses that in his *livestock judging game*, the players are able to view archived results (placing, etc.) compiled in a database. The scoring, placing and reasons for the results of the particular livestock are entered by an official judge and subsequently archived. Thus, Brink fails to

disclose a system that *operates without requiring any input from the instructor or outside source (official judge), other than the operator being tested*. In Brink, as stated above, an outside source (the official judge) provides the comments/reasoning for the placement of the livestock and this is later accessible by the user. Additionally, Brink discloses the use of livestock images that the judges use to rank the livestock, Brink can hardly be considered analogous to an interactive driving simulation system.

Further, Brink is *non-analogous art* to the present invention, because Brink discloses and relates to a method of conducting competitive livestock (animal) judging games by utilizing a plurality of communication media, e.g. Internet, etc. [0001]. Brink's stated object is to provide a livestock judging game via the Internet, to incorporate the use of a database that stores and archives the various comments, placing, etc., of the livestock which can later be accessed by a player and allowing players to read and hear the official judge's animal placement reasons by allowing players to access a pre-recorded audio clip of the judge's comments [0013].

Brink alleges that his livestock judging game overcomes the problems with the cited background art by providing the capabilities stated above. Therefore, given the nature of the livestock judging game of Brink, persons skilled in the art would recognize that: 1) it does not pertain to the field of endeavor of interactive driving simulation apparatus; and 2) Brink does not address a problem similar to those addressed and overcome by the claimed invention. Hence, persons skilled in the art would recognize that Brink's livestock judging game is not analogous to the presently claimed invention, and persons skilled in the art would not have (in the first instance) looked to Brink even if such persons were considering modifications to Aoki's and Busse's disclosed systems.

Based on the foregoing, applicant respectfully submits that the rejection of claims 1-3 and 6 under 35 USC 103 is overcome and respectfully requests that such rejection be reconsidered and withdrawn.

2. At page 8, item 8 of the Office Action the Examiner rejected claims 7-10 under 35 USC 103 as unpatentable over Aoki (US Patent No. 5,415,550) in view of Busse, Walker, Brink and Aoki.

The Examiner has taken the position that the combination of these references makes obvious all elements of the claimed invention. Thus, according to the Examiner, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the applied references to achieve the claimed invention.

Applicant's Response:

Upon careful consideration of the Examiner's rejection and the applied references applicant respectfully traverses such rejection for the substantially the same reasons stated in relation to claims 1-3 and 6 above. Moreover, applicant submits that the deficiencies of Walker, Brink, Busse, Aoki '071 are not overcome by any additional teachings of Aoki (US '550) or by the additional references cited by the Examiner. Specifically, applicant notes that none of the above references, when considered singly or in combination thereof, discloses the simultaneous display of simulated operating environment and *performance evaluation comments*, either audio or visual, which do not require any input from an outside source other than the operator being tested.

Regarding Aoki '550, applicant continues to maintain and assert its position as previously detailed in Amendments B and C, where it is noted that that Aoki '550 does not disclose a system of *automatically selecting performance evaluation comments* based on performance in relation to a specific performance criteria as claimed by Applicant's invention, claim 7. Rather, Aoki '550 discloses a system wherein the operator's responses are graded and an evaluation is made. Also, Aoki '550 discloses recording the entire riding simulation (col. 20, lines 46-50).

Based on the foregoing, applicant respectfully submits that the rejection of claims 7-10 under 35 USC 103 is overcome and respectfully requests that such rejection be reconsidered and withdrawn.

3. At page 12, item 9 of the Office Action the Examiner rejected claims 11-13 under 35

USC as unpatentable over Huston (US Patent No. 6,146,143) in view of Busse and Walker.

The Examiner has taken the position that in her view, the combination of these references makes obvious all elements of the claimed invention. Thus, according to the Examiner, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the applied references to achieve the claimed invention.

Applicant's Response:

Upon careful consideration of the Examiner's rejection and the applied references applicant respectfully traverses such rejection for substantially the same reasons stated above in relation to claims 1-3 and 6 and because the deficiencies of Walker and Busse are not overcome by any additional teachings of Huston.

For example, applicant respectfully notes that as shown in Figure 1 of the reference and as discussed in column Huston et al. is similar to the system of Aoki '071, in that two separate computer input stations are provided in the disclosed system, one for the student doing the driving simulation, and another to permit an instructor to provide input during the driving simulation. Again, this is quite different from applicant's claimed single-station driving simulation apparatus, in which performance evaluation comments are determined by the CPU without requiring concurrent input from an outside source other than the operator.

Huston discloses a vehicle simulation system in which a first user (student) participates in the simulation by operating vehicle control devices 8 in a driving station 2 in response to a sequence of visual images, and in which a second user (instructor) defines one or more traffic events and presents the traffic events during a simulation session to the first user (col. 5, lines 52-67). Huston discloses that the system allows the first user to view his performance during a simulation. Specifically, software presents statistical information pertaining the recently completed simulation session. The statistics may be presented graphically on the monitor 31, and include data such as elapsed time, speed limit conformance, etc. (col. 8, lines 23-37). In addition, Huston discloses that

the system allows the second user, such as a driving instructor, to revisit portions of the simulation session either during the course of the simulation or afterward. That is, the second user is permitted to selectively stop and freeze, or replay, the displayed image on the video means 6 so that the second user/instructor may discuss a driving situation with the first user (col. 8, lines 38-56).

Applicant submits that this is significantly different than the claimed invention, wherein the performance evaluation comments are generated by the system without the input from any outside source, such as an instructor or the like.

Based on the foregoing, applicant respectfully submits that the rejection of claims 11-13 under 35 USC 103 is overcome and respectfully requests that such rejection be reconsidered and withdrawn.

4. At page 15, item 11 of the Office Action the Examiner has rejected claims 15 and 16 under 35 USC 103 as unpatentable over Aoki '017, Aoki '550, Busse, Walker and Brink.

The Examiner has taken the position that in her view, the combination of these references makes obvious all elements of the claimed invention. Thus, according to the Examiner, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the applied references to achieve the claimed invention.

Applicant's Response:

Upon careful consideration of the Examiner's rejection and the applied references applicant respectfully traverses such rejection for substantially the same reasons provided in relation to claims 1-6 above.

Based on the foregoing, applicant respectfully submits that the rejection of claims 15 and 16 under 35 USC 103 is overcome and respectfully requests that such rejection be reconsidered and withdrawn.

CONCLUSION

In conclusion, applicant has overcome the Examiner's rejections of record. While applicant has considered all of the references of record, it is respectfully submitted that the interactive driving

simulation apparatus as defined by the present claims, is believed to be allowable over all of the prior art of record.

If the Examiner is not fully convinced of the allowability of all of the claims now in the application, Applicant respectfully requests that the Examiner telephonically contact Applicant's undersigned representative to expeditiously resolve any issues remaining in the prosecution of the application.

Favorable consideration is respectfully requested.

Respectfully submitted,

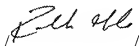


Customer No. 21828
Carrier, Blackman & Associates, P.C.
24101 Novi Road, Suite 100
Novi, Michigan 48375
August 11, 2008

William Blackman
Attorney for Applicant
Registration No. 32,397
(248) 344-4422

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Randhir Garcha

WDB/rg